

REMARKS

The Examiner is thanked for the thorough examination of the present application. The Office Action has, however, tentatively rejected all claims 1-22. Specifically, claims 1-6 were rejected under 35 U.S.C. 102(b) as allegedly anticipated by Kato (US 5,943,208). Applicant respectfully traverses the rejections for at least the reasons discussed below.

Independent claim 1, as amended, recites:

1. A fixing assembly for connecting and fixing a hard disk drive to an electronic device, comprising:
a mounting bracket for mounting a hard disk drive;
a cover flexibly engaged to the mounting bracket to engage the electronic device; and
a plurality of elastic members disposed between the mounting bracket and the cover to absorb vibration in three dimensions.

(Emphasis added.) Claim 1 patently defines over Kato for at least the reason that Kato fails to disclose the features emphasized above.

According to MPEP 706.02, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.

In contrast, Kato discloses a terminal device comprising a frame (10,20) and a base plate, wherein the frame (10,20) is for detachably mounting a storage device (41) and the base plate is for detachably mounting the frame (10,20) for mounting the storage device (41). However, the fixing assembly defined in claim 1 is an assembly comprising a mounting bracket, the cover, and the elastic members. According to Kato, the frame (10,20) is an individual component (fig.1, fig.19) and is not capable of absorbing vibration in three dimensions, as defined by the elastic members of claim 1. Therefore, the fixing assembly of claim 1 (as amended) is not anticipated by the frame (10,20) disclosed by Kato, and the rejection should be withdrawn.

As claim 1 patently defines over the cited art, dependent claims 2-6 patently define over the cited art for at least the same reason.

Claims 1-6 were also rejected under 35 U.S.C. 102(b) as allegedly anticipated by Blackborow (US 5,253,129). Applicant respectfully traverses the rejection for at least the reasons discussed below.

Among other features, claim 1 recites a fixing assembly comprising a mounting bracket, a cover, and a plurality of elastic members, wherein the cover is flexibly engaged to the mounting bracket and the elastic members are disposed between the mounting bracket and the cover to absorb vibration in three dimensions.

In contrast, Blackborow discloses a removable and transportable hard disk subsystem, which comprises a removable and transportable fixed disk module and a base housing (94). The base housing (94) includes a front opening and a hinged door (96), and the hinged door (96) is for closing the front opening.

However, the hinged door (96) is hingedly connected to the base housing (94) (col.9, line 13-14). In contrast, claim 1 defines the cover to be flexibly engaged to the mounting bracket. Therefore, the connection between the cover and the mounting bracket of claim 1 is different that the connection between the hinged door (96) and the base housing (94), as disclosed by Blackborow. According, claim 1 is not anticipated by the hinged door (96) disclosed by Blackborow, and therefore the rejection of claim 1 should be withdrawn.

Again, as claim 1 is patentable, claims 2-6 patently define over the cited art for at least the same reason.

The Office Action rejected claims 12-17 under 35 U.S.C 102(b) as allegedly anticipated by Kato. Applicant respectfully traverses the rejection for at least the reasons discussed below.

Like claim 1, independent claim 12 is amended herein to recite: "a plurality of elastic members disposed between the mounting bracket and the cover to absorb vibration in three dimensions.

In contrast, Kato discloses a terminal device comprising a frame (10,20) and a base plate. The frame (10,20) of Kato is for detachably mounting a storage device (41), and the base plate is for detachably mounting the frame (10,20) for mounting the storage device (41). In contrast, claim 12 defines a fixing assembly including a mounting bracket, a cover, and a elastic members. And, the frame (10,20) disclosed by Kato is an individual component (fig.1, fig.19) and not capable of absorbing vibration in three dimensions as the elastic members in claim 12. For at least this reason (and others discussed in connection with claim 1), claim 12 patently defines over Kato.

As claim 12 is patentable, dependent claims 13-17 patently define over the cited art for at least the same reason.

Claims 12-17 were also rejected under 35 U.S.C. 102(b) as allegedly anticipated by Blackborow. Applicant respectfully traverses the rejection for at least the reasons discussed below.

Claim 12 recites an electronic device, which comprises, among other features, a cover and a plurality of elastic members. The cover is defined as flexibly engaged to the mounting bracket and the elastic members are defined to be disposed between the mounting bracket and the cover to absorb vibration in three dimensions.

In contrast, Blackborow discloses a removable and transportable hard disk subsystem which comprises a removable and transportable fixed disk module and a base housing (94). The

base housing (94) includes a front opening and a hinged door (96), and the hinged door (96) is for closing the front opening.

However, the hinged door (96) is hinged connected to the base housing (94) (col.9, line 13-14), and the cover in claim 12 is flexibly engaged to the mounting bracket. Therefore, the connection between the cover and the mounting bracket in claim 12 is different to the connection between the hinged door (96) and the base housing (94) as disclosed by Blackborow. For reason similar to those described in connection with claim 1, claim 12 patently defines over Blackborow.

Since claim 12 is patentable, dependent claims 13-17 patently define over the cited art for at least the same reason.

Claims 8-11, 19-22 were rejected under 35 U.S.C. 103 (a) as allegedly unpatentable over Blackborow in view of Gamble (US 6,431,718 B1). As independent claim 1 and 12 are patentable, claims 8-11 and 19-22 also patently define over the cited art for at least the same reason.

As a separate and independent basis for the patentability of claims 8-11 and 19-22, Applicants respectfully traverse the rejections as failing to identify a proper basis for combining the cited references. In combining these references, the Office Action stated only that the combination would have been obvious "for keeping the hard disk more steady in horizontal directions since both of them are used to mount a hard disk drive." (Office Action, page 4). This alleged motivation is clearly improper in view of well-established Federal Circuit precedent.

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art

that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive an electronic device, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination").

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50

USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 ("The absence of such a suggestion to combine is dispositive in an obviousness determination.").

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).


For at least the additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections of claims 8-11 and 19-22 under 35 U.S.C. § 103, those rejections should be withdrawn.

CONCLUSION

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

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